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JAN 29 2010

In re Application of	:	
Moore	:	
Application No. 10/642,309	:	DECISION ON PETITION
Filed: August 18, 2003	:	PURSUANT TO
Attorney Docket No. 60707-1330	:	37 C.F.R. § 1.47(B)
Title: OPERATING SYSTEM FOR	:	
EXECUTING COMPUTER SOFTWARE	:	
APPLICATIONS	:	

This is in response to the petition pursuant to 37 C.F.R.
§ 1.47(b), filed November 23, 2009.

This petition is **DISMISSED**.

On August 18, 2003 this application was filed with an unexecuted declaration, identifying Mark Justin Moore as the sole inventor. On August 18, 2004, an executed declaration was submitted, along with the surcharge associated with the late submission of the same. In a final Office action mailed on December 12, 2007, a non-final Office action mailed on July 2, 2008, and a final Office action mailed on January 21, 2009, the Examiner objected to the declaration.

A grantable petition under 37 C.F.R. § 1.47(b) requires:

- (1) the petition fee of as set forth in 37 C.F.R. § 1.17(g);
- (2) the surcharge as set forth in 37 C.F.R. § 1.16(e), if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventor;

- (4) proof that either:
 - (a) a copy of the application was sent or given to the non-signing inventor for review and proof that the non-signing inventor refused to sign, or;
 - (b) proof that diligent efforts have been made to locate the non-signing inventor
- (5) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (6) proof of irreparable damage, and;
- (7) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 C.F.R. § 1.63.

With this petition, Petitioner has submitted, *inter alia*, the petition fee, a statement of facts, an assertion that the non-signing inventor cannot be found,¹ and the last known address of the non-signing inventor.²

Requirements (1) - (3) of Rule 1.47(b) have been satisfied. Requirements (4) - (7) have not been satisfied.

Regarding the fourth requirement of Rule 1.47(b), Petitioner has indicated that he has inquired with the non-signing inventor's former co-workers,³ performed "multiple Internet searches" for this individual,⁴ and neither these communications nor these searches were successful in locating this individual.⁵ *As Petitioner has set forth that the non-signing inventor cannot be found or reached, Petitioner is required to establish that a diligent effort was made to locate this individual.* However the cursory searches that were performed for the non-signing inventor using three online search engines and inquiring with former co-workers do not constitute a diligent effort at locating this individual. The record does not support a finding that diligent attempts were made to obtain a forwarding address or to locate the non-signing inventor by means such as through telephone, databases, or a private locator service. If such searches are performed, and are sufficiently broad so as to provide a reasonable opportunity to locate this individual, and it is then

1 Petition, pages 1 and 4.

2 Petition, page 3.

3 Petition, page 2. See also Exhibits C4 and C5.

4 Petition, page 2. See also Exhibit C6 and C7.

5 Exhibits C5 and C7.

averred that such attempts failed, then Petitioner will have provided the necessary proof required under 37 C.F.R. § 1.47 that the non-signing inventor cannot be reached. Details of the efforts to locate the non-signing inventor are to be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Regarding the fifth requirement of Rule 1.47(b), Petitioner has failed to prove sufficient proprietary interest in the subject matter to justify the filing of the application. More specifically, Petitioner has included a copy of the assignment document where the non-singing inventor assigned his rights to Conexant Systems (Exhibit B1), however Petitioner has not established the right of the purported assignee to take action, pursuant to 37 C.F.R. § 3.73. See also MPEP § 324. On renewed petition, Petitioner should both include a statement pursuant to 37 C.F.R. § 3.73(b) and record a copy of the assignment which constitutes Exhibit B1.

Regarding the sixth requirement of Rule 1.47(b), no proof of irreparable damage has been submitted.⁶ A statement by Rule 47(b) applicant that the filing is necessary to preserve the rights of the parties would be sufficient to address this requirement.

Regarding the seventh requirement of Rule 1.47(b), Petitioner has not submitted an oath or declaration that overcomes the Examiner's objections. On renewed petition, Petitioner should include a declaration that contains the proper language and has been executed in accordance with MPEP § 409.03(b). Petitioner should ensure that the declaration is executed in such a manner that clearly indicates that the individual who executes the declaration is not an inventive entity.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.47(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any such renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,⁷ hand-delivery,⁸ or facsimile.⁹ Registered

⁶ See MPEP § 409.03(g).

⁷ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁸ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹⁰

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.¹¹ All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

9 (571) 273-8300- please note this is a central facsimile number.

10 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

11 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).